

## **REMARKS/ARGUMENTS**

In the February 10, 2009 Office Action, the Examiner rejected claims 1-11 pending in the application. This response amends claims 1, 3, and 6-8 for further consideration. After entry of the foregoing amendments, claims 1-11 (1 independent claim; 11 total claims) remain pending in the application. Reconsideration is respectfully requested.

The Examiner first rejected claims 7-8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner stated that there was no antecedent basis for “the plugs” in claims 7 and 8. In response to the Examiner’s rejection, Applicant has amended claims 6, 7, and 8 so that all claims consistently refer to the same plug members.

Claims 1-3 and 5-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Carl, U.S. Patent No. 5,497,670 (hereafter “Carl”). In particular, the Examiner states that Carl teaches an apparatus for transferring pipette tips comprising a transfer plate 16 having a plurality of plug members (cylinders 26) where the plug members engage the pipette tips 20 disposed in a frame 18. The Examiner further states that Carl teaches the frame 18 being assembled and interlocked with the transfer plate via shafts 12, 14. The Examiner also contends that the frame 18 has openings (see Fig. 5) for inserting the plug members 26 therethrough to engage the pipette tips 20. Finally, the Examiner states that the frame 18 includes a plurality of protuberances 22, 28 which are smaller than the plug members 26 and extend into the openings (see Fig. 7).

Applicant previously submitted arguments that independent claim 1 requires that the transfer plate 16 have (i.e. include) a plurality of plug members as part of the transfer plate and that the pipette tip plate holder 16 in Carl does not include plug members or cylinders and instead includes openings through which cylinders 26 are moved. The Examiner disagrees with this argument presented by Applicant and contends that the terms “having” or “including” in patent parlance do not necessarily mean “part of” or “connected to”. The Examiner further contends that the transfer plate 16 includes the plug members 26 in the transfer plate 16 throughout the operation of the Carl device and that therefore, giving the claims the broadest reasonable interpretation, the transfer plate 16 of Carl has (i.e. includes) a plurality of plug members 26.

Applicant respectfully traverses the Examiner's rejection and also respectfully disagrees with the Examiner's interpretation of Applicant's claims in light of Carl. However, in order to more clearly claim Applicant's invention, Applicant has amended its independent claim 1 to state that the plurality of plug members are part of the transfer plate and that the protuberances are part of the frame. It is clear that Carl fails to disclose a transfer plate having a plurality of plug members that are part of the transfer plate. Carl also fails to disclose a frame having openings contained therein for inserting the plug members therethrough and a plurality of protuberances where the protuberances are part of the frame. Accordingly, in that Carl fails to disclose each of the elements of Applicant's amended independent claim 1, Carl cannot anticipate Applicant's amended independent claim 1.

With respect to the Examiner's rejection of claim 2 under 35 U.S.C. §102(b), the Examiner contends that the plug members 26 are arranged in parallel lines separated by elongated slots (openings in the plate 16). Applicant respectfully traverses this rejection. Applicant's dependent claim 2 includes all of the limitations of Applicant's amended independent claim 1. Accordingly, like Applicant's independent claim 1, Carl fails to disclose each of the elements of Applicant's dependent claim 2 and in particular those same claim elements that Carl fails to disclose with respect to Applicant's amended independent claim 1. Furthermore, Applicant respectfully disagrees that the plug members 26 in Carl are arranged in parallel lines and separated by elongated slots. The common known definition of a slot is "a narrow opening or groove." (See Merriam-Webster's Collegiate Dictionary; 10<sup>th</sup> Edition). Unlike Applicant's claimed invention and associated drawings, Carl fails to disclose plug members that are separated by elongated narrow openings or elongated grooves.

With regard to the Examiner's rejection under 35 U.S.C. §102(b) of claim 3, the Examiner contends that the openings in the frame 18 of Carl comprise "elongated" slots separated by "elongated" rails. The Examiner further states that the limitation "elongated slots" reads on the openings and the frame in which the pipette tips are disposed as shown in Fig. 5. The Examiner further states that the limitation "elongated rails" reads on the area between the openings in which the tips are disposed as shown in Fig. 5 with hatched lines. Finally, the Examiner contends that the dimensions of the openings or slots are not defined in the claim or the specification and that therefore the openings of Carl in the frame and the area in-between the openings can be considered "elongated slots" to one of ordinary skill.

Applicant's currently amended claim 3 requires that the frame include horizontal elongated slots separated by elongated rails. The openings in frame 18 of Carl do not comprise horizontal elongated slots. In addition, Carl also fails to disclose a transfer plate having a plurality of plug members where the plurality of plug members are part of the transfer plate and a frame having openings contained therein and a plurality of protuberances extending into the openings where the protuberances are part of the frame – both of which are also required in Applicant's amended claim 3.

With regard to the Examiner's 35 U.S.C. §102(b) rejection of Applicant's claims 5-11, all of which require the elements contained in Applicant's currently amended independent claim 1, Applicant herein incorporates Applicant's previously set forth arguments in their entirety regarding Carl's failure to anticipate Applicant's independent claim 1. In particular, Carl fails to disclose a transfer plate having a plurality of plug members where the plug members are a part of the transfer plate and a frame having openings contained therein and a plurality of protuberances extending into the openings where the protuberances are part of the frame.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Carl. In particular, the Examiner states that although Carl fails to explicitly teach that the transfer plate and the frame are comprised of a molded plastic, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to construct the transfer plate and frame from a moldable plastic since the skilled artisan would be able to determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature. Applicant respectfully traverses this rejection. Applicant's dependent claim 4 includes all of the elements of Applicant's currently amended independent claim 1. Accordingly, like Applicant's independent claim 1, Carl fails to disclose a transfer plate having a plurality of plug members where the plug members are part of the transfer plate. In addition, Carl fails to disclose a frame having openings contained therein and a plurality of protuberances extending into the openings where the protuberances are part of the frame. Accordingly, Applicant's claim 4 cannot be deemed obvious given the Carl reference.

In view of the foregoing, Applicant respectfully submits that all of the pending claims fully comply with 35 U.S.C. §112 and are allowable over the prior art of record. Reconsideration of the application and allowance of all pending claims is earnestly solicited.

Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to telephone the undersigned at the Examiner's convenience. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814. **This statement does NOT authorize charge of the issue fee.**

Dated: July 2, 2009

Respectfully submitted,

By \_\_\_\_\_



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